REMARKS

Claims 1-10 and 12-23 are all the claims pending in the application. Claims 1-15 stand

rejected by the Examiner. Claims 1, 2, and 5-8 stand rejected under 35 U.S.C. § 102(b) over

U.S. Pre-Grant Published Application No. 2001/0008872 A1 to Nakano ("Nakano"). Claims 1

and 3 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,197,460 to Tamaoki et al.

("Tamaoki"). Claims 1, 4, 6, 7, 9, and 10 stand rejected under 35 U.S.C. § 102(e) over U.S.

Patent No. 6,778,205 to Anderson et al. ("Anderson"). Claims 11, 12, 14, and 15 stand rejected

under 35 U.S.C. § 103(a) over Anderson in view of U.S. Patent No. 6,363,040 to Murata

("Murata"). Claim 13 stands rejected under 35 U.S.C. § 103(a) over Anderson in view of Murata

and in further view of Nakano.

Claims 1, 3, 6, and 12-15, are hereby amended, and claim 11 is hereby canceled. Claim 3

is amended only to rewrite it into independent form. Claims 16-23 are added to more fully claim

the invention disclosed in the specification.

Claim Rejections Under 35 U.S.C. § 102

A.   Claims 1-5

Of claims 1-5, independent claim 1 stands rejected under 35 U.S.C. § 102(b) over

Nakano, under 35 U.S.C. § 102(b) over Tamaoki, and under 35 U.S.C. § 102(e) over Anderson.

Amended claim 1 requires that "said storage layer and said indication layer are coupled

by lamination." Although Nakano appears to disclose a storage layer and a rewritable indication

layer in paragraphs 10 and 19, Nakano only appears to disclose a rewritable indication layer as a

label which may be attached to a recording medium by an adhesive layer. Nakano fails to

disclose coupling the indication layer to the recording medium by lamination. Since Nakano

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fails to disclose this element of amended claim 1, claim 1 and its dependent claims 2-5 are not anticipated by Nakano.

Amended claim 1 further requires that "said recording medium is substantially planar and circular in shape." Although Tamaoki appears to disclose a storage layer and a rewritable indication layer in col. 1, lines 36-40, and col. 3, lines 56-81, the only storage layer disclosed in col. 1, lines 36-40 is a "magnetic ticket." Tamaoki fails to disclose a storage layer as part of a magnetic or optical disc. Since Tamaoki fails to disclose this element of amended claim 1, Tamaoki fails to anticipate claim 1 and its dependent claims 2-5.

Claim 1 also requires that "at least a portion of the indication information which has been written can be rewritten." Anderson appears to disclose a storage layer and an indication layer in Fig. 3A, Elements 202 and 302. Regarding the indication layer, the Examiner cites Anderson at col. 4, lines 28-29, where Anderson describes Element 302 as a "writable label layer." Although Anderson, here, appears to disclose a writable indication layer, Anderson fails to teach the capability to rewrite indication data on this layer. Since Anderson fails to teach this element of claim 1, claim 1 is not anticipated by Anderson.

Since claim 1 as amended is patentable over the applied references as set forth above, Applicant respectfully requests that the Examiner withdraw the rejections of claims 1-5 under 35 U.S.C. §§ 102(b) and 102(e) over the applied references Nakano, Tamaoki, and Anderson.

Furthermore, claim 3 describes an indication layer with a cholesteric layer and electrode. The Examiner cites Tamaoki for teaching features of claim 3 by effectively citing the substantively recorded data layer of the recording medium as the indication layer. Tamaoki

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relates to a temperature sensitive cholesteric recording material. The recording is by heat

application via a thermal head and includes fixing by immersion into ice water baths. (Tamaoki

at col. 4, lines 51, 62.) Accordingly, there is no inherent requirement that the recording structure

would include the electrode structure as described in claim 3. The constant submersion of the

medium into a water bath would tend to teach away from the structure as claimed.

B.   Claims 6-10

Of claims 6-10, claims 6-8 stand rejected under 35 U.S.C. § 102(b) over Nakano, and

claims 6, 7, 9, and 10 stand rejected under 35 U.S.C. § 102(e) over Anderson.

Claim 6 is amended to incorporate the elements of claim 11. Since claim 6 as amended is

patentable over the applied references, as discussed below, dependent claims 7-10 are also

patentable at least by virtue of their dependency from claim 6. Applicant, therefore, respectfully

requests that the Examiner should therefore withdraw the rejection of claims 6-10 under 35

U.S.C. §§ 102(b) and 102(e).

Claim Rejections Under 35 U.S.C. § 103

A.   Claims 11-15

Claims 11, 12, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

over Anderson in view of Murata. Claim 13 stands rejected under 35 U.S.C. § 103(a) over

Anderson in view of Murata and in further view of Nakano. Claim 11 is canceled, and its subject

matter is incorporated into claim 6. Accordingly, dependent claims 12-15 are amended to

depend from claim 6. Thus, Applicant addresses the Examiner's arguments to claim 11 with

respect to amended claim 6.

Regarding the elements of amended claim 6, the Examiner contends that a motivation to combine Anderson with Murata is that "by comparing stored data to data ready to be read from memory, redundant information would not be stored on the disc." (Office Action at 6.) The Examiner further contends that "Murata discloses detecting the difference between stored data and data which is to be read from memory (see Figure 1, Elements S17, S19-22 and Figure 4)." (Office Action at 6.)

Applicant respectfully submits that the Examiner uses the language "detecting the difference between stored data and data which is to be read from memory," which is different from any required element of amended claim 6, but must direct any rejection to an element of amended claim 6 as written.

Moreover, Applicant submits that the portions of Murata cited by the Examiner do not teach or suggest "detecting a difference between storage data which is stored . . . and new data which is to be subsequently stored," as required by amended claim 6. For example, the cited steps of Fig. 1 merely appear to disclose determining whether there is a match in the last track number between the lead-in information and the PMA, and Fig. 2 merely appears to disclose new data written to the disc after previously written data. Nowhere does Murata appear to teach or suggest the above-quoted element of amended claim 6. Thus, for at least this reason, independent claim 6 and its dependent claims 12-15, are patentable over Murata. Applicant, therefore, respectfully requests that the Examiner withdraw Murata as a reference, and withdraw the rejection of amended claims 6 and 12-15 under 35 U.S.C. § 103(a).

Furthermore, the applied references fail to teach or suggest "a generating section" as required by amended claim 6. None of the applied references teach or suggest generating "indication information which corresponds to the difference," or writing such generated indication information to the indication layer of the disc, as required by amended claim 6 and its dependent claims 12-15. For at least these further reasons, claims 6 and 12-15 are, thus, patentable over the applied references, and Applicant respectfully requests that the Examiner withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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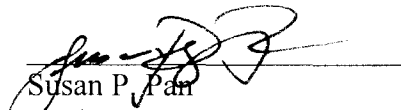
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